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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,170	11/13/2006	Frank B. Stamps	0837RF-H532-US	5513

38441 7590 09/09/2010
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EXAMINER

BURCH, MELODY M

ART UNIT	PAPER NUMBER
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3657

NOTIFICATION DATE	DELIVERY MODE
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09/09/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JIM@WALTONPLLC.COM

Office Action Summary	Application No. 10/568,170	Applicant(s) STAMPS ET AL.	
	Examiner Melody M. Burch	Art Unit 3657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/29/10, 8/16/10</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5788372 to Jones et al.

Re: claims 1 and 3. Jones et al. show in figures 1b and 2 a damper having an adjustable spring rate comprising a damper having an adjustable spring rate comprising a piston 53 having an axis, an outer surface and opposing ends, a housing 51, elastomeric seals 55a, 55b in sealing contact with the outer surface of the piston, the seals being coaxial with the piston and limiting movement of the piston to a path along the axis of the piston, the seals also defining fluid chambers 61a, 61b adjacent the ends of the piston, the seals also being fixed to the housing, a primary passage 42, 56 communicating the fluid chambers and a selectively switchable valve 20c or 20b for controlling a flow of fluid from one of the chambers to another of the chambers through the primary passage, such that when the selectively switchable valve is open, the flow of fluid through the primary passage is not resisted by the selectively switchable valve in either direction; further when the selectively switchable valve is closed, the flow of fluid through the primary passage is restricted in both directions by the selectively switchable valve; and wherein when the flow of fluid through the primary passage is permitted,

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movement of the piston is resisted by a first spring rate due to a shear force required to cause shear deflection of the at least one seal, and when the flow of fluid through the primary passage is restricted, movement of the piston is resisted by a second spring rate due to a fluid force required to cause bulging deflection of the at least one seal.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5374039 to Schmidt et al.

Re: claim 20. Schmidt et al. show in figures 6 and 7 a damper having an adjustable spring rate comprising a damper having an adjustable spring rate comprising a piston 22, 55 having an axis, an outer surface and opposing ends, a housing 32, at least one elastomeric seal 24 in sealing contact with the outer surface of the piston, the at least one seal being coaxial with the piston and limiting movement of the piston to a path along the axis of the piston, the at least one seal also defining fluid chambers adjacent the ends of the piston, the at least one seal also being fixed to the housing, a primary passage shown in the area of 84 and 98 in figure 7 communicating the fluid chambers and a selectively switchable valve 82 for controlling a flow of fluid from one of the chambers to another of the chambers through the primary passage; and wherein when the flow of fluid through the primary passage is permitted, movement of the piston

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is resisted by a first spring rate due to a shear force required to cause shear deflection of the at least one seal, and when the flow of fluid through the primary passage is restricted, movement of the piston is resisted by a second spring rate due to a fluid force required to cause bulging deflection of the at least one seal.

Schmidt et al. are silent with regards to the at least one seal being a plurality of seals. In *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.

5. Claims 1, 3, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5788372 to Jones et al.

Re: claims 1, 3, and 5. Jones et al. show in figure 4 a damper having an adjustable spring rate comprising a damper having an adjustable spring rate comprising a piston 53 or 53f having an axis, an outer surface and opposing ends, a housing 51 or 51f, at least one elastomeric seal 55f in sealing contact with the outer surface of the piston, the at least one seal being coaxial with the piston and limiting movement of the piston to a path along the axis of the piston, the at least one seal also defining fluid chambers 61f' and 61f'' adjacent the ends of the piston, the at least one seal also being fixed to the housing, a primary passage 42f communicating the fluid chambers and a selectively switchable valve 20f (without the orifice) for controlling a flow of fluid from one of the chambers to another of the chambers through the primary passage, such that when the selectively switchable valve is open, the flow of fluid through the primary passage is not resisted by the selectively switchable valve in either direction; further

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when the selectively switchable valve is closed, the flow of fluid through the primary passage is restricted in both directions by the selectively switchable valve; and wherein when the flow of fluid through the primary passage is permitted, movement of the piston is resisted by a first spring rate due to a shear force required to cause shear deflection of the at least one seal, and when the flow of fluid through the primary passage is restricted, movement of the piston is resisted by a second spring rate due to a fluid force required to cause bulging deflection of the at least one seal.

Jones et al. are silent with regards to the at least one seal being a plurality of seals. In *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. in view of US Patent 5535861 to Young.

Re: claim 2. Jones et al. or as modified are silent with regards to the elastomeric seals being formed of layers of an elastomeric material and a rigid non elastomeric material.

Young teaches the use of elastomeric seals being formed of layers of an elastomeric material 23 and a rigid non elastomeric material 26.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the elastomeric seals of Jones et al. or as modified to have included layers of an elastomeric material and a rigid non elastomeric

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material, as taught by Young, in order to provide a means of having seals with adequate stiffness for improved product reliability.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. in view of US Patent Application 2006/0162778 to Nichols et al.

Jones et al. or as modified include a switchable valve that is pressure operated but are silent with regards to the switchable valve being electrically operated.

Nichols et al. teach in paragraph [0021] that pressure operated valves may be switched to electrically operated solenoid valves.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the pressure operated valve of Jones et al. or as modified to have been electrically operated, in view of the teachings Nichols et al., in order to provide an alternate but functionally equivalent means of enabling and restricting fluid flow.

8. Claims 6-10, 11, 13, and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. in view of US Patent 2774553 to Jensen.

Re: claims 6, 7, 11, 13, 15 and 16. Jones et al. or as modified are silent with regards to the secondary passage communicating the fluid chambers.

Jensen teaches in figure 5 the limitation of a damper comprising a secondary passage 146 communicating fluid chambers 110, 112 which is located in the piston 108.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the damper of Jones et al. or as modified to have

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included a secondary passage located in the piston, in view of the teachings of Jensen, in order to provide damping in both directions as suggested by Jensen.

Re: claims 8, 9, 17, and 18. Jones et al. or as modified are silent with regards to the damper comprising a bypass passage for limiting the pressure imbalance between the fluid chambers.

Jensen teaches in figure 5 a damper comprising a bypass passage 148 located in the piston 108.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the damper of Jones et al. or as modified to have included a bypass passage in the piston, as taught by Jensen, in order to provide a means of relieving pressure in one of the chambers when it exceeds a certain limit as suggested by Jensen.

Re: claims 10 and 19. Jensen teaches in figure 5 the use of a spring loaded bypass valve located within the bypass passage 148.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the bypass passage of Jones et al., as modified, to have included a bypass valve, as taught by Jensen, in order to provide a means of selectively relieving pressure based on the pressure achieving a desired limit selecting depending on the particular application.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. in view of US Patent 2774553 to Jensen as applied to claim 11 above, and further in view of US Patent 5535861 to Young.

Re: claim 12. Jones et al., as modified, are silent with regards to the elastomeric seals being formed of layers of an elastomeric material and a rigid non elastomeric material.

Young teaches the use of elastomeric seals being formed of layers of an elastomeric material 23 and a rigid non elastomeric material 26.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the elastomeric seals of Jones et al., as modified, to have included layers of an elastomeric material and a rigid non elastomeric material, as taught by Young, in order to provide a means of having seals with adequate stiffness for improved product reliability.

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. in view of US Patent 2774553 to Jensen as applied to claim 11 above, and further in view of US Patent Application 2006/0162778 to Nichols et al.

Jones et al., as modified, include a switchable valve that is pressure operated but are silent with regards to the switchable valve being electrically operated.

Nichols et al. teach in paragraph [0021] that pressure operated valves may be switched to electrically operated solenoid valves.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the pressure operated valve of Jones et al., as modified, to have been electrically operated, in view of the teachings Nichols et al., in order to provide an alternate but functionally equivalent means of enabling and restricting fluid flow.

Response to Arguments

11. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

12. Applicant's arguments filed 6/21/10 have been fully considered but they are not persuasive. Applicant argues that the Office action fails to articulate how Schmidt discloses or teaches the limitation of selectively controlling an amount of fluid flow through the passage such that movement of the piston is resisted by a total spring rate which is the sum of a first spring rate due to a shear force required to cause shear deflection of the seals and a second spring rate due to a force required to cause bulging deflection of the seals by fluid pressure induced by the movement of the piston.

Examiner notes that paragraph [0026] of the published application describes that the first spring rate due to a shear force required to cause shear deflection of the seals results from relatively free fluid flow between the two chambers as well as the seals being fixedly attached to the housing and the piston. In Schmidt Examiner notes that the at least one seal 24 is fixedly attached to the piston 22, 55 and the housing 32 and when the switchable valve 82 is open there is relatively free fluid flow between the two chambers resulting in the first spring rate due to shear deflection of the at least one seal to the same extent as Applicant's invention. On the other hand, when the switchable valve 82 is closed there is relatively restricted fluid flow between the two chambers resulting in the second spring rate due to a force required to cause bulging deflection of the at least one seal by fluid pressure induced by the movement of the piston to the

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same extent as Applicant's invention as described in paragraph [0027]. Accordingly, the rejection of claim 20 has been maintained.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection for independent claims 1 and 11 and their respective dependent claims presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 571-272-7114. The examiner can normally be reached on Monday-Friday (6:30 AM-3:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on 571-272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mmb

September 6, 2010

/Melody M. Burch/

Primary Examiner, Art Unit 3657